



One South Church Avenue
Suite 1700
Tucson, Arizona 85701-1621
520.770.8700
Fax 520.623.2418
www.quarles.com

Attorneys at Law in
Milwaukee and Madison, Wisconsin
Naples and Boca Raton, Florida
Phoenix and Tucson, Arizona
Chicago, Illinois (Quarles & Brady LLC)

RECEIVED
CENTRAL FAX CENTER
MAY 13 2005

Facsimile Transmission Form

Date: May 13, 2005

To:	Fax No.	Phone No.
Name William T. Leader Technology Center 1700, Art Unit 1742 U.S. Patent and Trademark Office	703-872-9306	

From:	Gavin J. Milczarek-Desai	520-770-2235	520-770-8716
Re:	APPLICANT: M. Michael Pitts, Jr. et al. DOCKET NO.: 111732.00012 SERIAL NO.: 10/796,814 EXAMINER: William T. Leader FILED: March 9, 2004 ART UNIT: 1742 TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS		

Attachment(s):	Transmittal of Terminal Disclaimer Terminal Disclaimer signed by attorney of record
----------------	--

**IF YOU HAVE PROBLEMS RECEIVING THIS FACSIMILE, PLEASE CALL US IMMEDIATELY AT:
520-770-8741**

No. of Pages (Including Cover):	4	Job Code:	
Client - Matter No.:	111732.00012	Time Keeper:	GMILCZAR
Recipient:		Return To:	Alice Vanicek
Requestor Name:	Alice Vanicek	Phone No.:	520-770-8741

IMPORTANT: THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED AND/OR CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA REGULAR POSTAL SERVICE. THANK YOU.

RECEIVED
CENTRAL FAX CENTER
MAY 13 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: M. Michael Pitts, Jr. et al.

DOCKET NO.: 111732.00012

SERIAL NO.: 10/796,814

EXAMINER: William T. Leader

FILED: March 9, 2004

ART UNIT: 1742

TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION
OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Antonio R. Durando
Quarles & Brady Streich Lang
One South Church Avenue, Suite 1700
Tucson, AZ 85701

CERTIFICATE OF TRANSMISSION

I hereby certify that on this 13th day of May, 2005, this correspondence is being transmitted to the attention of Examiner William T. Leader, via facsimile (703-872-9306) to the U.S. Patent and Trademark Office, Patent Technology Center 1700, Art Unit 1742.

By: Alice B. Vanicek
Alice B. Vanicek

TO THE COMMISSIONER FOR PATENTS

Transmittal of Terminal Disclaimer

Dear Sir:

Further to applicant's Supplementary Response and petition for three-months extension of time filed on May 10, 2005, and in response to the communication dated May 9, 2005, from Examiner Leader stating the reply filed on March 9, 2005, is not fully responsive to the prior Office Action,

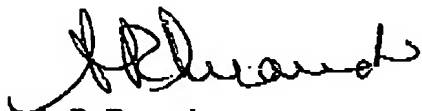
*S.N. 10/796,814**Art Unit 1742*

attached is a Terminal Disclaimer signed by the undersigned attorney, who is of record in the subject application

A fee authorization form for the terminal disclaimer fee under 37 CFR 1.20(d) was submitted in the previous Response. A petition for a 3-month extension of time was submitted with the documents filed May 10, 2005. Should there be any additional or unforeseen costs, please charge our Deposit Account No. 17-0055.

Respectfully submitted,

Quarles & Brady Streich Lang LLP



Antonio R. Durando
Reg. No. 28,409

520 770-8700 Telephone
520 623-2418 Fax

MAY 13 2005

PTO/SB/26 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)

111732.00012

In re Application of: M. Michael Pitts, Jr. and Rodrigo F.V. Romo

Application No.: 10/796,814

Filed: March 9, 2004

For: Capacitive Electrostatic Process for Inhibiting the Formation of Biofilm Deposits in Membrane-Separation Systems

The owners M. Michael Pitts, Jr. and Rodrigo F.V. Romo, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 5,591,317 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer." In the event that said prior patent later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 28,409



Signature

May 12, 2005

Date

Antonio R. Durando

Typed or printed name

520-770-8700
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included. Please charge the terminal disclaimer fee of \$65.00 (small entity) to Deposit Account No. 17-0055.
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2036.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.